

## REMARKS

### Claim Rejection

Rejected claim 4 is amended, without prejudice or disclaimer, to contain only the subject matter of the allowable claims 14-18, which were objected to for depending on rejected claim 4. In this regard, the subject matter of these claims 14-18 are added at the end of claim 4 in the alternate as conditions I, II, III, IV and V, one of which must be satisfied.

This amendment readily renders the rejection of claim 4 moot.

Coincidentally, it also attends to the objected to claims 25, 30, and 32, which were dependent ultimately on claim 4 also.

### Withdrawn Claims

Withdrawn claims 8, 12 and 34 are directed to method/processes of use of the subject matter of the allowed claims. Applicants bring the attention of the Examiner to *MPEP § 821.04*, Rejoinder, which states that “if the elected invention is directed to the product and the claims directed to the product are subsequently found patentable, process claims [both process of making and using] which either depend from or include all the limitations of the allowable product will be rejoined.” Accordingly, the rejoinder, examination and allowance of these non-elected claims is respectfully requested in accord with the rejoinder provisions of the MPEP.

Withdrawn claims 10 and 35 are directed to products comprising the subject matter of the allowed claims. The articles of these product claims are combinations of the compounds of the elected and now allowed claims and other components. As such, it is respectfully submitted that the compounds of the elected claims and the combination of said compounds and other components are related as combination-subcombination. Since they are related as combination-subcombination, the standard for requiring restriction herein is not met.

In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated. To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e. separate classification, status, or field of search. See MPEP §808.02. If it can be shown that a combination, as claimed

(1) does not require the particulars of the

subcombination as claimed for patentability (to show novelty and unobviousness), and

(2) the subcombination can be shown to have utility either by itself or in other and different relations, the inventions are distinct. When these factors cannot be shown, such inventions are not distinct.

(Emphasis added.) (*M.P.E.P. §806.05(c)*)

It is submitted that the first requirement for two-way distinctness is not established herein. The combination does require the particulars of the subcombination. The products of claims 10 and 35 all require the exact same products (allowed compounds) of the same scope as the subcombination claims of the elected group. To this end, the combination claims are even dependent upon the subcombination-product claims and the subcombination-products are an essential distinguishing feature of the combination-products.

It is respectfully submitted that when the relationship between the claimed subject and the subject matter of these withdrawn claims is properly characterized, there is no basis for restriction herein. Thus, the restriction requirement should be withdrawn.

Moreover, the Patent Office has not established that it would pose a serious or undue burden on the Examiner to search all the groups. No further, or only a minimal, search would be necessary to allow the remaining groups since the elected claims on which these withdrawn claims depend are allowed. This is so because if the elected products (compounds) themselves are patentable, products comprising the said allowed compounds, or methods of use of said allowed compounds, should be also readily patentable as well.

Reconsideration is respectfully and courteously solicited.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

/Csaba Henter/

---

Csaba Henter, Reg. No. 50,908  
Attorney for Applicants

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.  
Arlington Courthouse Plaza 1  
2200 Clarendon Boulevard, Suite 1400  
Arlington, VA 22201  
Telephone: 703-243-6333  
Facsimile: 703-243-6410  
Attorney Docket No.:MERCK-2991

Date: April 9, 2009

K:\Merck\2000 - 2999\2991\Reply Apr 09.doc